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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/713,711	11/14/2003	Robert P. Badrak	WEAT/0127.C1	2073

7590 12/02/2004

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EXAMINER

THOMPSON, KENNETH L

ART UNIT	PAPER NUMBER
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3672

DATE MAILED: 12/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/713,711

Applicant(s)

BADRAK ET AL.

Examiner

Kenn Thompson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 September 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21-48 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 21-37 and 40-46 is/are rejected.
- 7) ☒ Claim(s) 38,39,47 and 48 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 14 May; 10 Sept 04.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 21-37, 40 and 45 are rejected under 35 U.S.C. 102(e) as being anticipated by Baugh et al., U.S. 6,446,724.

Regarding claim 21, Baugh et al. discloses an apparatus for use in a wellbore. Baugh et al. discloses a tubular having a preformed bypass (10,76) at an upper end thereof for circulating a fluid. Baugh et al. discloses a preformed gripping surface (64) connected to an outside surface of the upper end of the tubular, the gripping surface disposed circumferentially adjacent the preformed bypass.

As to claim 22, Baugh et al. discloses a sealing band (26) disposed around the outside surface of the upper end.

As to claim 23, Baugh et al. discloses the gripping surface comprises teeth (72).

As to claim 24, Baugh et al. discloses the gripping surface comprises grit (col. 5, lines 48-51; cement is considered to be "grit").

As to claim 25, Baugh et al. discloses the gripping surface comprises a slip (col. 1, lines 14-17).

As to claim 26, Baugh et al. discloses the upper end (18) is tapered .

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Regarding claim 27, Baugh et al. discloses an apparatus for use in a wellbore. Baugh et al. discloses a tubular having a preformed bypass (76) for circulating a fluid; and a tool (82) having at least one radially extendable member (64).

As to claim 28, Baugh et al. discloses the at least one radially extendable member (64) of the tool (82) is disposed adjacent the preformed bypass (76).

As to claim 29, Baugh et al. discloses the tool is fluid pressure actuated by pressurized fluid delivered in a tubular string (col. 2, lines 13-18).

As to claim 30, Baugh et al. discloses a shearable connection (90) between the tubular (92) and the tool (94; 92 becomes deformed by forces tending to produce a shearing strain).

As to claim 31, Baugh et al. discloses an expander (16) capable of expanding a longitudinal section of the tubular.

As to claim 32, Baugh et al. discloses a gripping surface (42) connected to an outside surface of the upper end of the tubular, the gripping surface disposed circumferentially adjacent the preformed bypass.

Regarding claim 33, Baugh et al. discloses placing a tubular (10) in the wellbore, the tubular having a gripping surface (42) connected to an outside surface of the tubular at a first location and a preformed bypass (inner bore of 14) for circulating a fluid disposed at a second location. Baugh et al. discloses expanding the tubular at the first location into substantial contact with an inner diameter of the wellbore (12), and circulating the fluid into the wellbore (col. 5, lines 27-40).

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As to claim 34, Baugh et al. discloses expanding the entire circumference of at least a portion of the tubular (10) into substantial contact with the inner diameter of the wellbore (12; col. 5, lines 11-21).

As to claim 35, Baugh et al. discloses reforming the tubular (by complete circumferential expansion) and expanding the entire circumference of at least a portion of the tubular into substantial contact with the inner diameter of the wellbore (12; col. 5, lines 11-21).

As to claim 36, Baugh et al. discloses circulating the fluid into the wellbore comprises circulating cement into the wellbore through a run-in string and allowing returns to pass through the bypass (col. 2, line 65 – col. 3, line 3).

Regarding claim 37, Baugh et al. discloses placing a tubular (10) in the wellbore, the tubular having a preformed bypass (inner bore of 14) at an upper end thereof for circulating a fluid; placing a tool (64) having at least one radially extendable member in the wellbore (col. 53-66); expanding a portion of the tubular to selectively place portions (42) of the tubular circumferentially adjacent the preformed bypass into frictional contact with a surrounding surface; and circulating the fluid into the wellbore.

As to claim 40, Baugh et al. discloses circulating the fluid into the wellbore comprises circulating cement into the wellbore through a run-in string (tubular 10) and allowing returns to pass through the bypass (col. 2, line 65 – col. 3, line 3).

As to claim 45, Baugh et al. discloses the gripping surface (42) remains connected to the outside surface of the tubular at the first location after expanding the tubular at the first location into substantial contact with the wellbore.

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The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 41 is rejected under 35 U.S.C. 102(b) as being anticipated by Vance Sr., U.S. 5,220,959.

Regarding claim 41, Vance Sr. discloses a tubular (12) having a preformed bypass (internal bore of 12) at an upper end thereof for circulating a fluid, wherein the upper end (15) is tapered (via 28) to a smaller maximum outer diameter (at 16) than a maximum outer diameter (29) of a lower end of the tubular; and a gripping surface (30) disposed on an outside surface of the upper end of the tubular, the gripping surface disposed circumferentially adjacent the preformed bypass.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 42-44 and 46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baugh et al., U.S. 6,446,724 in view of Vance Sr., U.S. 5,220,959.

As to claims 42, 44 and 46, Baugh et al. discloses the gripping surface (42) as being the upper wall of the tubular. Baugh does not disclose the gripping surface being at least partially embedded in a wall of the tubular. Vance, Sr. teaches in figure 3 use of a gripping surface (38)

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embedded in the wall of the tubular (15) to provide a mechanical connection between the tubular and the gripping surface which enhances the frictional fit between the tubular and the wellbore. It would have been obvious to one having ordinary skill in the art at the time of the invention to arrange for the upper wall of the tubular disclosed by Baugh et al. to have an embedded gripping surface as taught by Vance, Sr. to enhance frictional fit between the tubular and the wall since a mechanical connection between the gripping surface and the expandable member adds a degree of permanence of the connection.

As to claim 43, Vance, Sr. teaches use of the gripping surface (38) being integral with a wall of the tubular (15).

Allowable Subject Matter

Claims 38, 39, 47 and 48 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter:

The prior art of record does not disclose or suggest all the claimed subject matter including expanding the entire circumference of at least a portion of the tubular into substantial contact with the surrounding surface using the tool.

The prior art of record does not disclose or suggest all the claimed subject matter including the gripping surfaces fixedly connected to the portions of the tubular at a location.

Response to Arguments

Applicant's arguments filed 10 September 2004 have been fully considered but they are not persuasive.

Applicant argues with respect to claims 21-32 the second, fourth and fifth embodiments disclosed by Baugh et al. do not teach show or suggest a tubular having a preformed bypass at an upper end thereof for circulating a fluid.

Reference numbers from embodiments used in the rejection of claims 21-26 disclose the limitations of the claims. Please see rejection above.

Applicant argues the first embodiment of the prior art does not have a gripping surface connected to an outside surface of the upper end of the tubular.

The first embodiment of the prior art discloses a surface at 22 connected to an outside surface of the upper end of the tubular 10. Specific structural limitations for what constitutes a gripping surface is absent from the claims, as such the upper end of the tubular suffice comparably. The surface at the upper end 22 is connected to the tubular 10 outer surface, the items being monolithic, a specific connection is not required by the claim.

Applicant argues the third embodiment of the prior art, figures 12-15 and the sixth embodiment, figures 27-30 do not teach, show or suggest all the limitations of claims 21-26.

Those specific embodiments were not used in the rejection of the claims above.

Applicant argues the spaces 76 and passages of the prior art are not preformed but are formed downhole.

The apparatus claim does not require the passages, spaces or bypass to be formed downhole. The recitation "preformed" is baseless without a an additional claimed method step.

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Applicant argues the grapple members, comparable to the claimed teeth, are not preformed to grip for the tubular member.

The claims require the first location to contact for the tubular, not the gripping surface.

Applicant argues the prior art does not disclose a slip.

Specific structural limitations for what constitutes a slip is absent for the claims.

Applicant argues cement is not a preformed gripping surface recited in claims 21-26, because the cement is inserted into the annulus downhole and cannot suspend the tubular from the casing until the cement is cured after its insertion into the annulus. Additionally, cement is not connected to the outside surface of the tubular in any of the embodiments disclosed in Baugh et al. and is not a gripping surface.

The claims require the gripping surface to comprise or have grit. The gripping surface has no claimed functionality. The cement disclosed by the prior art is at least in the vicinity of the gripping surface, which meets the limitation to comprise.

Applicant argues with respect to claims 33-36 the bypass of the prior art are not preformed but are formed downhole.

The method claim does not require the bypass to be formed downhole. The recitation "preformed" is used in an attempt to structurally limit and is not presented a method step.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kenn Thompson whose telephone number is 703 306-5760. The examiner can normally be reached on 7:00 am - 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David J Bagnell can be reached on 703 308-2151. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

29 November 2004



Kenn Thompson
Primary Patent Examiner
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